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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

LEE, PHILIP C

ART UNIT PAPER NUMBER

2154

DATE MAILED: 08/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/771,158

Applicant(s)

COPP ET AL.

Examiner

Philip C. Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-22, 24 and 26-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-22, 24, 26-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. This action is responsive to the amendment and remarks filed on May 13, 2005.
2. Claims 14-22, 24 and 26-32 are presented for examination and claims 1-13, 23 and 25 are canceled.
3. The text of those sections of Title 35, U.S. code not included in this office action can be found in a prior office action.

Claim Rejections – 35 USC 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 14, 16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sorkin et al, U.S. Patent 5,898,823 (hereinafter Sorkin) in view of Laser Jet Series 4050 Printer Model Specific MIB.

6. Sorkin and Laser Jet Series 4050 Printer Model Specific MIB were cited in the last office action.

7. As per claims 14, Sorkin taught the invention substantially as claimed for a client to discover a peripheral address, by way of a peripheral server, the method comprising:

receiving a first message at the peripheral server, wherein the first message contains an address of the client (col. 2, lines 20-27), and wherein the first message is formatted as a print job, and wherein the print job including no content resulting in a printed output (col. 2, lines 27-32); and

receiving at the client a second message containing the peripheral address (col. 2, lines 27-32).

8. Sorkin did not teach wherein the print job contains a Peripheral Management Language (PML) object. Laser Jet Series 4050 Printer Model Specific MIB taught wherein the print job contains a PML object, and wherein the PML object is UI_SELECT_OPTION (i.e. HELD_JOB_DELETE or PORTn_DESCRIPTION) (page 51; page 124, paragraph 2; page 128, paragraph 3; page 183, paragraph 2). (see response to point (1) below for detail explanations)

9. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Sorkin and Laser Jet Series 4050 Printer Model Specific MIB because Laser Jet Series 4050 Printer Model Specific MIB's teaching of print job

containing a PML object would increase the efficiency of Sorkin's system by allowing embedded information to be transmitted with the print job in a single message.

(Note that the "Official Notice" taken in the last office action for the concept of using different type of PML object is supported by the Laser Jet Series 4050 Printer Model Specific MIB.

Therefore, a new ground of rejection is established.)

10. As per claim 16, Sorkin taught the invention substantially as claimed comprising:

a client computer (col. 4, lines 29-32)

a peripheral server, connected to the client computer, wherein the peripheral server receives a first message from the client computer, the first message containing an address of the client computer (col. 4, lines 29-35, 56-58); and

a peripheral, connected to the peripheral server, wherein the peripheral receives the first message from the peripheral server and notifies the client computer of the peripheral's address (col. 4, lines 36-39), wherein:

the first message is formatted as a print job, the print job including no content resulting in a printed output (col. 4, lines 59-61);

the peripheral includes at least one non-printer function (col. 4, lines 4-10); and

the client computer is configured to access the at least one non-printer function of the peripheral using the peripheral's address and without using the peripheral server (col. 2, lines 39-41; col. 4, lines 48-51).

11. Sorkin did not teach wherein the print job contains a PML object. Laser Jet Series 4050 Printer Model Specific MIB taught wherein the print job contains a PML object, and wherein the PML object is UI_SELECT_OPTION (i.e. HELD_JOB_DELETE or PORTn_DESCRIPTION) (page 51; page 124, paragraph 2; page 128, paragraph 3; page 183, paragraph 2). (see response to point (1) below for detail explanations)

12. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Sorkin and Laser Jet Series 4050 Printer Model Specific MIB because Laser Jet Series 4050 Printer Model Specific MIB's teaching of print job containing a PML object would increase the efficiency of Sorkin's system by allowing embedded information to be transmitted with the print job in a single message. (Note that the "Official Notice" taken in the last office action for the concept of using different type of PML object is supported by the Laser Jet Series 4050 Printer Model Specific MIB. Therefore, a new ground of rejection is established.)

13. As per claim 18, Sorkin and Laser Jet Series 4050 Printer Model Specific MIB taught the invention substantially as claimed in claim 16 above. Sorkin further taught wherein the peripheral server comprises a print queue (col. 3, lines 52-55; col. 1, lines 26-32).

14. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sorkin and Laser Jet Series 4050 Printer Model Specific MIB in view of Manglapus et al, U. S. Patent 6,219,151 (hereinafter Manglapus).

15. Manglapus was cited in the last office action.

16. As per claim 17, Sorkin and Laser Jet Series 4050 Printer Model Specific MIB did not teach wherein the interface generates a message to the client computer. Manglapus taught wherein the second message is generated by peripheral with a built-in network interface (fig. 3; col. 5, lines 33-37; col. 10, lines 59-62).

17. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Sorkin, Laser Jet Series 4050 Printer Model Specific MIB and Manglapus because Manglapus's system of generating message with a network interface would increase the flexibility of their systems by allowing the peripheral to connect to the network with different configuration.

18. Claims 15, 19-22, 24, 27, 29 and 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sorkin, Laser Jet Series 4050 Printer Model Specific MIB and in view of Bacher et al, U. S. Patent 6,728,012 (hereinafter Bacher).

19. Bacher was cited in the last office action.

20. As per claims 15, 19 and 20, Sorkin and Laser Jet Series 4050 Printer Model Specific MIB taught the invention substantially as claimed in claims 14 and 16 above. Although, Sorkin

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taught wherein the peripheral is a printer, the peripheral server is a print server comprising a print queue, and the first message is spooled to the peripheral from the peripheral server by way of the print queue (col. 3, lines 27-32), however, Sorkin and Laser Jet Series 4050 Printer Model Specific MIB did not teach wherein the peripheral is a multi-function printer. Bacher taught wherein the peripheral is a multi-function peripheral (abstract; col. 2, lines 45-54).

21. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Sorkin, Laser Jet Series 4050 Printer Model Specific MIB and Bacher because Bacher's multi-function peripheral would increase the field of use in their systems by allowing Sorkin's and Laser Jet Series 4050 Printer Model Specific MIB's systems to be utilized on a multifunction terminal for executing printing, scanning, copying and fax transmission (col. 2, lines 45-47).

22. As per claim 21, Sorkin taught the invention substantially as claimed comprising:
sending a first message from a client to a peripheral server by way of a network, the first message including a network address of the client (col. 4, lines 29-35, 56-58), and wherein the first message is formatted as a print job (col. 2, lines 27-32);
sending the first message from the peripheral server to a peripheral by way of the network (col. 4, lines 33-35);
sending a second message from the peripheral to the client by way of the network, the second message including a network address of the peripheral (col. 4, lines 36-39); and

accessing a non-printer function of the peripheral by way of the network using the client and the network address of the peripheral and without using the peripheral server (col. 2, lines 39-41; col. 4, lines 4-10, 48-51).

23. Sorkin did not teach wherein the print job contains a Peripheral Management Language (PML) object. Laser Jet Series 4050 Printer Model Specific MIB taught wherein the print job contains a PML object, and wherein the PML object is UI_SELECT_OPTION (i.e. HELD_JOB_DELETE or PORTn_DESCRIPTION) (page 51; page 124, paragraph 2; page 128, paragraph 3; page 183, paragraph 2). (see response to point (1) below for detail explanations)

24. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Sorkin and Laser Jet Series 4050 Printer Model Specific MIB because Laser Jet Series 4050 Printer Model Specific MIB's teaching of print job containing a PML object would increase the efficiency of Sorkin's system by allowing embedded information to be transmitted with the print job in a single message.

25. Sorkin and Laser Jet Series 4050 Printer Model Specific MIB did not teach a multi-function peripheral. Bacher taught that the peripheral is a multi-function peripheral (Abstract; col. 2, lines 45-54).

26. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Sorkin, Laser Jet Series 4050 Printer Model

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Specific MIB and Bacher because Bacher's multi-function peripheral would increase the field of use in their systems by allowing Sorkin's and Laser Jet Series 4050 Printer Model Specific MIB's systems to be utilized on a multifunction terminal for executing printing, scanning, copying and fax transmission (col. 2, lines 45-47).

27. As per claim 22, Sorkin, Laser Jet Series 4050 Printer Model Specific MIB and Bacher taught the invention substantially as claimed in claim 21 above. Sorkin and Bacher further taught wherein:

the multifunction peripheral includes a printer function (see Bacher, abstract; col. 2, lines 45-54); and

the peripheral server includes a print queue (see Sorkin, col. 3, lines 52-55; col. 1, lines 26-32).

28. As per claim 24, Sorkin, Laser Jet Series 4050 Printer Model Specific MIB and Bacher taught the invention substantially as claimed in claim 21 above. Sorkin further taught wherein the print job includes no content resulting in a printed output (col. 2, lines 31-32).

29. As per claims 27 and 32, Sorkin, Laser Jet Series 4050 Printer Model Specific MIB and Bacher taught the invention substantially as claimed in claim 21 above. Bacher further taught wherein the non-printer function of the multifunction peripheral is a scanning function, a facsimile function, or a copier function (Abstract; col. 2, lines 45-54).

30. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Sorkin, Laser Jet Series 4050 Printer Model Specific MIB and Bacher because Bacher's multi-function peripheral would increase the field of use in their systems by allowing Sorkin's and Laser Jet Series 4050 Printer Model Specific MIB's systems to be utilized on a multifunction terminal for executing printing, scanning, copying and fax transmission (col. 2, lines 45-47).

31. As per claim 29, Sorkin, Laser Jet Series 4050 Printer Model Specific MIB and Bacher taught the invention substantially as claimed in claim 21 above. Sorkin further taught wherein the second message is generated directly by the multifunction peripheral (col. 4, lines 36-39).

32. As per claim 31, Sorkin, Laser Jet Series 4050 Printer Model Specific MIB and Bacher taught the invention substantially as claimed in claim 21 above. Sorkin further taught comprising placing the first message into a print queue of the peripheral server prior to sending the first message to the multifunction peripheral (col. 1, lines 26-32; col. 3, lines 52-55).

33. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sorkin, Laser Jet Series 4050 Printer Model Specific MIB and Bacher in view of "Official Notice".

34. As per claim 28, Sorkin, Laser Jet Series 4050 Printer Model Specific MIB and Bacher taught the invention substantially as claimed in claim 21 above. Sorkin, Laser Jet Series 4050 Printer Model Specific MIB and Bacher did not specifically detailing the formatted of the

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message as a UDP datagram. "Official Notice" is taken for the concept of message formatted as a UDP datagram is known and accepted in the art. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to include message formatted as a UDP datagram because by doing so it would increase the efficiency by allowing faster transmission of data message over the Internet.

35. Claims 26 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sorkin, Laser Jet Series 4050 Printer Model Specific MIB and Bacher in view of Manglapus.

36. As per claims 26 and 30, Sorkin, Laser Jet Series 4050 Printer Model Specific MIB and Bacher taught the invention substantially as claimed in claim 21. Sorkin, Laser Jet Series 4050 Printer Model Specific MIB and Bacher did not specifically detailing the message is generated by a separate interface device between the peripheral server and the peripheral. Manglapus taught wherein the second message is generated by peripheral with a built-in network interface (fig. 3; col. 5, lines 33-37; col. 10, lines 59-62).

37. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Sorkin, Laser Jet Series 4050 Printer Model Specific MIB, Bacher and Manglapus because Manglapus's system generating message with a network interface would increase the flexibility of Sorkin's, Laser Jet Series 4050 Printer Model Specific MIB's and Bacher's systems by allowing the peripheral to connect to the network with different configuration.

38. Applicant's arguments with respect to claims 14-22, 24 and 26-32, filed 05/13/05, have been fully considered but are not deemed to be persuasive and are moot in view of the new grounds of rejection.

39. In the remark applicant argued that

(1) the prior art of record fails to teach a Peripheral Management Language (PML) object, and wherein the PML object is UI_SELECT_OPTION.

(2) Bacher fail to teach sending the first message from the peripheral server to a multifunction peripheral by way of the network, sending a second message from the multifunction peripheral to the client by way of the network, the second message including a network address of the multifunction peripheral, and then accessing a non-printer function of the multifunction peripheral by way of he network using the client and the network address of the multifunction peripheral and without using he peripheral server, as recited in combination with the other features and limitation of claim 21.

40. In response to point (1), Applicant argument to overcome the rejection of the prior art of record is not persuasive. In particular, page 11, lines 15-17, applicant argued that one of ordinary skill in the art would not have been aware that the PML object UI_SELECT_OPTION

even existed. Furthermore, page 11, lines 19-22, applicant state “the mere existence of one PML does not render the existence of a second PML obvious, and moreover, the particular use of a first PML does not render the use of a second PML obvious for an entirely different purpose”.

41. Applicant’s arguments amount to no more than the concept of using PML to create different object command, there is no description of the purpose of the PML object UI_SELECT_OPTION. The only description of the PML object UI_SELECT_OPTION in the specification states “In one embodiment, the peripheral is a printer, the peripheral server is a print queue, and the first message is a print job containing a PML object, such as UI SELECT OPTION.” (page 2, lines 14-16), and “In the embodiment detailed below, the predetermined variable is a PML (peripheral management language) object, preferably UI-SELECT OPTION.”(page 5, lines 4-5). This is just a mere preference of the PML object use in an embodiment of the invention, it did not describe the purpose of the PML object UI_SELECT_OPTION, not even the abbreviation of “UI”. At most, the use of PML object UI_SELECT_OPTION can only be interpreted as a PML object use for an unknown purpose.

42. Accordingly, the examiner rejected the limitation of the PML object UI_SELECT_OPTION with Laser Jet Series 4040 Printer Model Specific MIB which teaches the concept of using PML object for different commands including HELD_JOB_DELETE and PORTn_DESCRIPTION (page 51; page 124, paragraph 2; page 128, paragraph 3; page 183, paragraph 2). This means that peripheral management language (PML) is used for creating object commands (HELD_JOB_DELETE, PORTn_DESCRIPTION, etc.) for accomplishing

different purpose. One of ordinary skill in the art can create different object command names for the desire purpose. This concept is clearly shown in the reference Laser Jet Series 4040 Printer Model Specific MIB. Note that since the function of PML object UI_SELECT_OPTION is not defined in the specification, it can be interpreted as performing the function of PML object HELD_JOB_DELETE or PORTn_DESCRIPTION with a different name.

43. In response to point (2), page 15, line 26-page 16, line 1, applicant states “There is no way to combine elements selected from Sorkin, and then to somehow combine those elements with other element selected from Bacher, in order to arrive at the invention as recited by claim 21, as amended. Applicant further states on page 16, lines 4-6 that “none of the references cited thus far in the case record provide, teach or suggest the PML object UI_SELECT_OPTION of claim 21.” Since the limitation of PML object UI_SELECT_OPTION is already addressed above, this response will address to the combine elements of Sorkin and Bacher.


44. As cited in paragraphs 22-26 of this office action, Sorkin taught all of the elements of claim 21 except PML object UI_SELECT_OPTION (previously addressed above) and a multifunction peripheral. Bacher taught an invention for execution of job transmission for a multifunction peripheral, which is in the same field as Sorkin’s invention. Furthermore, Bacher did not teach away from the invention of Sorkin. The teaching of Sorkin’s can be combined with the teaching of Bacher. This would allow Sorkin’s method to be utilized on a multifunction terminal for executing printing, scanning, copying and fax transmission. The combination of

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Sorkin, Laser Jet Series 4040 Printer Model Specific MIB and Bacher taught all of the limitation of claim 21 as amended.

45. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Lee whose telephone number is (571) 272-3967. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9600.

Philip Lee


JOHN E. COLLANSBEE
SUPERVISOR, EXAMINER
TECHNOLOGY CENTER 2100